

Application No. 09/988,548
Applicant: Bernd LUHMANN et al
Amendment Under 37 CFR §1.111 dated February 23, 2005

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 24-35 were rejected under 35 USC § 112, first paragraph, as containing new matter. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

According to the Examiner, the "whereby" clause of claim 24 lacks antecedent basis in the original specification, and, therefore, claim 24 claims new matter. Applicants respectfully disagree.

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The "whereby" clause of claim 24 is amended above to delete the word "stripping," and to make some other editorial changes. The amended clause reads as follows:

"whereby the backing is selected such that the backing would tear if pulled by itself with the same force necessary to remove said adhesive tape from said substrate, but the backing does not tear when said adhesive tape is removed from said substrate."

This "whereby" clause embodies two tests that must be satisfied in order to read on the claims:

- (1) the backing *would tear* if pulled by itself (backing alone) with the same force necessary to remove the adhesive tape from the substrate; and
- (2) the backing *does not tear* when the adhesive tape (backing + adhesive) is removed from the substrate.

Example 1 in the instant specification provides two examples of backings that meet both tests. Therefore, it can be seen that Applicants' specification does, in fact, convey possession of

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the subject matter of claims 24-35. Consequently, claims 24-35 do not contain new matter.

The adhesive tapes of Samples 3.009 and 3.010 both *tore* before the adhesive tape could be removed from the substrate. The tearing was not only of the adhesive, but of the backings as well. Consequently, the backings of Samples 3.009 and 3.010 cannot themselves be strong enough to resist the force necessary to remove the adhesive tape from the substrate. If they were, then the adhesive tapes would not have torn. On the other hand, if the backings tore when combined with the adhesive, the backings would tear by themselves. Consequently, the backings of Samples 3.009 and 3.010 satisfy test 1. They would tear if by themselves subjected to the same force necessary to remove the adhesive tapes from substrates to which they were adhered.

The adhesive tapes of Samples 3.001A and 3.006 have the *same backings* as Samples 3.009 and 3.010, respectively, i.e., weak, tearable backings. Yet, the adhesive tapes of Samples 3.001A and 3.006 did *not* tear. Consequently, Samples 3.001A and 3.006 satisfy test 2. The backings of these adhesive tapes did not tear when the adhesive tape was removed from a substrate to which it was adhered.

In other words, Samples 3.001A and 3.006 contain backings that:

- (1) would tear under the necessary stripping force in the absence of the adhesive, but

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(2) do not tear in the presence of an appropriate adhesive.

This is all that is covered by the “whereby” clause of claims 24-35, and this is demonstrated in the original examples. Consequently, claims 24-35 do not introduce new matter, but, instead, are amply supported by the original disclosure.

Collectively, these results demonstrate that a weak backing (one that would tear under the force necessary to strip an adhesive tape containing the backing from a substrate) can be combined with the proper selection of an adhesive composition to provide a strong adhesive tape that does not tear even in the backing component when the adhesive tape is removed from a substrate. This concept is embodied in Samples 3.001A and 3.006, and the explanation above proves that Applicants had possession of such tapes at the time the present application was filed. Consequently, claims 24-35 do not claim new matter.

The Examiner says he doesn't understand how the backing could be pulled in the absence of an adhesive. According to the Examiner, if no adhesive is holding the backing on the substrate it would seem that the backing could not tear. In response, Applicants point out that there is nothing in the “whereby” clause of claim 24 that provides that the uncoated backing is bound to a substrate. The backing could be grasped at both ends, for example, by metal grasping

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devices, and subjected to the force by pulling the metal grasping devices apart from one another. There is nothing in the "whereby" clause of claim 24 that requires that the uncoated backing is bound to a substrate by an adhesive. The first test of the "whereby" clause is that the backing would tear if subjected to the required force. Persons skilled in the art understand that such force can be applied in ways other than by adhering the backing to a substrate.

Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 12-35 were rejected under 35 U.S.C. § 103(a) as being obvious over WO 95/06691 (hereinafter "the cited reference" or "Bries.") In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Applicants respectfully request that the Examiner document his allegedly "well known fact" that "the type and amount of adhesive influences the removable characteristics of the tape."

Applicants also respectfully request that the Examiner explain in detail how the "whereby" clause of claim 24 defines this well known fact. Applicants respectfully submit that there is no teaching or suggestion in the prior art of record that a *backing* that would ordinarily tear under the stripping force required to remove an adhesive tape from a substrate could be made

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untearable simply by the appropriate choice of *adhesive* properties. There is no foundation for this in the cited prior art, nor has the Examiner established this to be well known.

Further, it cannot be inherent as instant Examples 3.009 and 3.010 show that every adhesive choice does not render the backing untearable. In instant Examples 3.009 and 3.010, the adhesive tape tore in spite of the fact that the backings were coated with adhesive.

There is no teaching or suggestion of this property in Bries, and the Examiner has not pointed to any specific teaching of Bries wherein this property must necessarily exist. Consequently, Bries is inadequate as an anticipation, or to show obviousness.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well. An early notice to that effect is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

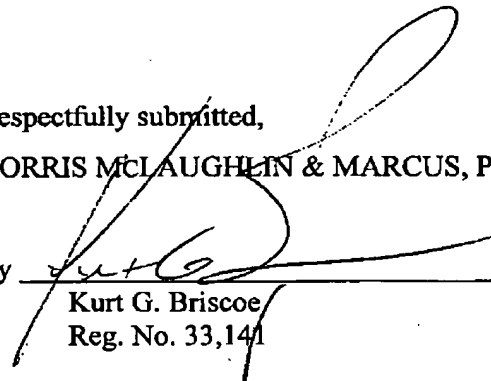
Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be

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promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
NORRIS McLAUGHLIN & MARCUS, P.A.

By 
Kurt G. Briscoe
Reg. No. 33,141

KGB/ja

875 Third Avenue
18th Floor
New York, New York 10022
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (15 pages total) is being transmitted via facsimile to the United States Patent and Trademark Office on the date indicated below:

Date: February 23, 2005

By 
Kurt G. Briscoe